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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,794	06/01/2000	Glenn Rolus Borgward	65705-0002	1859

10291 7590 06/26/2002

RADER, FISHMAN & GRAUER PLLC  
39533 WOODWARD AVENUE  
SUITE 140  
BLOOMFIELD HILLS, MI 48304-0610

EXAMINER

MENGISTU, AMARE

ART UNIT PAPER NUMBER

2673

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/508,794

Applicant(s)  
Glenn R. Borgward

Examiner  
AMARE MENGISTU

Art Unit  
2673



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 47-75 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some\* c) ☐ None of:

- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Art Unit: 2673

## **DETAILED ACTION**

### *Specification*

1. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- © Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CAR 1.52(e)(5)).
- (e) Background of the Invention.
  1. Field of the Invention.

Art Unit: 2673

2. Description of the Related Art including information disclosed under 37  
CAR 1.97 and 1.98.

- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CAR 1.821-1.825).

2. The numbering of claims is not in accordance with 37 CAR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 30-58 have been renumbered as claims 47-75.

3. Claims 30-46 are objected to because of the following informalities: The original claims 30-46 are not examined because these claims depend on canceled claim 29. Applicant is advised to cancel the original claims 30-46.

Art Unit: 2673

***Claim Rejections - 35 U.S.C. § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 64-75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not provide support to the claim limitation “*when corresponding predetermined pairs of operating elements are actuated simultaneously or when corresponding predetermined pairs of operating elements are actually immediately in secession, or when a corresponding predetermined operating elements is operating immediately in succession*”. The disclosure does not enable one skill in the art as to how a pair of operating elements are actuated simultaneously or actually immediately in succession or operated twice immediately in succession.

***Claim Rejections - 35 U.S.C. § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2673

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 47-58,60-70,72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman et al** (5,893,132) in view of **Eberhard et al** (6,331,867).

As to claims 47-58,60-70,72-75 **Huffman et al** ( hereinafter **Huffman** ) discloses an electronic book comprising: a casing having a sheet-like display unit and at least one flat screen/touch screen type display (fig.1.(100); fig.2 (130,132); col.4, lines 32-38); at least one input means/manipulation region (fig.4 (170); , fig.21 (360)); operating elements (fig.4 (172,174,176 and 178), col.8, lines 36-42, lines 51-64,, for example; a multifunction key such as “ *a series of buttons, a mouse.* ” col.8, lines 41-42) adapted to be actuated and located within the manipulation region; said operating elements, individually triggering leafing through function for navigating in the book content displayed (col.8, lines 51- col.9, lines 6); providing functions for selection menus (fig.11 (254-258,267-269)); with reading matter being represented in the sheet like display unit (see, figs. 7, 17-24).

**Huffman** did not expressly detailed the operating function specific mode of operation; but one skilled in the art would have recognized that **Huffman** can perform a first operating function is not associated with a symbol or reading matter (see, col.5, lines 63- col.6, lines 36) and a second operating function is associated with symbol or reading matter (see, fig.7, col.8, lines 26-33 col. 10, lines 41-51) as an operating function **modes**. **Huffman** also fails to teach that the operating elements are located within the manipulation region outside of the range of the sheet like display unit and operating elements are actuated immediately in succession. However, the

Art Unit: 2673

patent of **Eberhard et al** (hereinafter **Eberhard**) clearly teaches that it is well known for electronic books to have operating elements are located within the manipulation region outside of the range of the sheet like display unit (see, fig.2 (80,82,84,86)) without shifting the wrist of the user's hand and operating elements could also be actuated immediately in succession (see, fig.2 (82,86); col.6, lines 6- 46), a coupling means (fig.1 ); means connected with said coupling means for automatically reading out data from data carrier unit and means for determining, by using the data read out from the data carrier unit (see, fig. 1, col.3, lines 40-54, col.4, lines 27-58).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to incorporate the method of having an operating element located outside the display unit as taught by **Eberhard** in the device of **Huffman** because this will allow the user an easy way of manipulating the operating elements with out interning with the displayed material.

8. Claims 59 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman et al** (5,893,132) in view of **Eberhard et al** (6,331,867). as applied to claims 47-58,60-70,72-75 above, and further in view of **Lebby et al** (5,534,888) .

As to claims 59 and 73, **Huffman** as modified by **Eberhard** disclose a voice synthesizer (fig.1 (162)), but has failed to teach that the input device being a microphone. **Lebby et al** clearly suggest the use of a microphone in an electronic book as an input device (fig.5 9567)).

Art Unit: 2673

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have used the microphone of **Lebby's** into the system of **Huffman** as modified by **Eberhard** because this is an improvement for Huffman since this will provide for a hand caped person to input information without the use of hand.

9. *Any inquiry concerning this communication should be directed to Amare Mengistu at telephone number (703) 305-4880.*

***Any response to this action should be mailed to:***

*Commissioner of Patents and Trademarks*

*Washington, D.C. 20231*

***or faxed to:***

*(703) 872-9314, (for formal communications intended for entry)*

***Or:***

*(for informal or draft communications, please label "PROPOSED"*

*or "DRAFT")*

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington. VA., Sixth Floor (Receptionist).*

*Any inquiry of a general nature or relating to the status of this application  
or proceeding should be directed to the Technology Center 2600 Customer Service  
Office whose telephone number is (703)306-0377*



Application/Control Number: 09/508,794

Page 8

Art Unit: 2673

*A. Mengistu*

*Art unit 2673*

*June 24, 2002*

  
**Amare Mengistu**  
**Primary Examiner**